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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/001,775 | 11/13/2001 | Harold D. Kopkie | P 1032.11002 | 2196 |

7590 08/27/2003

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EXAMINER

SORKIN, DAVID L

ART UNIT

PAPER NUMBER

1723

DATE MAILED: 08/27/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|------------------------------------|-------------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 10/001,775 | KOPKIE, HAROLD D. |
| | Examiner David L. Sorkin | Art Unit 1723 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 23 October 2002.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) 1-4 and 6 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 5 and 7 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
 If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s) _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2 | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-4, drawn to a paint shaker, classified in class 366, subclass 211.
 - II. Claims 5 and 7, drawn to a reciprocating motor, classified in class 91, subclass 49.

Note: Improper multiple dependent claim 6 has not been grouped above. While it appears to be consistent with Group I, the examiner reserves judgment until the claim is amended to be proper. Claim 6 is objected to herein below, but has not otherwise been examined. See MPEP 608.01(n) regarding USPTO handling of improperly multiple dependent claims.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the combination does not require many features of the subcombination including the cylinder, piston, spring and valve. The subcombination has separate utility such as driving a reciprocating drill. Claim 1 is

considered to be an "evidence claim" of separate patentability of the combination. See MPEP 806.05(c)(III).

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. Because these inventions are distinct for the reasons given above and the searches required for Group I and for Group II are different, restriction for examination purposes as indicated is proper.

5. During a telephone conversation with Garth Janke on 28 July 2003 a provisional election was made without traverse to prosecute the invention of Group II, claims . Affirmation of this election must be made by applicant in replying to this Office action. Claims 5 and 7 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Objections

6. Claim 6 is objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim must only depended upon other claims in the alternative. Claim 6 requires the limitations of both claim 1 and claim 5, not in the alternative. See MPEP § 608.01(n). Accordingly, claim 6 has not been further treated on the merits.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 7 depends from claim 5. Claim 5 is directed to "A motor for a paint shaker". However, claim 7 recites "The paint shaker of claim 5". Therefore, it is unclear whether claim 7 is directed to a motor or a paint shaker.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 5 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Bannister (US 2,345,024). Note: regarding the preamble statement of intended use of claim 5, "for a paint shaker", as held in *Rowe v. Dror*, 42 USPQ2d 1550, 1553 (Fed. Cir. 1997), "where a patentee defines a structurally complete invention in the claim body and uses the preamble only to state a purpose or intended use for the invention, the preamble is not a claim limitation". Further regarding claim 5, Bannister ('024) discloses a motor comprising a cylinder (10) having an inlet end (top end in Fig. 1) and an outlet end (bottom end in Fig. 1), said inlet end having an air inlet (12,13) for receiving compressed air and being otherwise substantially air-tight (see page 1, col. 2, lines 49-51), said outlet end being adapted for exhausting the compressed air (see page 2, col. 1, lines 13-33; Fig. 1); a piston (20) slidably disposed in said cylinder (see page 1, col. 1, lines 51-53); a compression spring (33) for biasing said piston toward said inlet end of

said cylinder (see page 2, col. 1, line 20); a valve comprising a displaceable stopper (22) and an associated valve seat (an upper surface of 21, see Fig. 1 and page 1, col. 1, lines 51-55), wherein said piston includes a passageway (21) for conducting the compressed air to said valve, wherein said stopper is adapted to seat against said valve seat in response thereto and thereby to close said valve, wherein said cylinder includes a member (19, 28) adapted to unseat said stopper and thereby allow the compressed air to enter said outlet end of said cylinder when said piston moves toward said outlet end so that said stopper reaches a predetermined point of contact with said member (see page 1, col. 2, lines 19-29). Regarding claim 7, said member is a projection (19, 28) supported by the outlet end of said cylinder (see Fig. 1).

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David L. Sorkin whose telephone number is 703-308-1121. The examiner can normally be reached on 8:00 -5:30 Mon.-Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda L. Walker can be reached on 703-308-0457. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

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David Sorkin

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